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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,432	06/04/2001	Kelli H. Kennedy	10007276-1	5664

7590 08/22/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/874,432

Applicant(s)

KENNEDY ET AL.

Examiner

Joseph R. Maniwang

Art Unit

2144

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-8, 10, 11, 13-16 and 18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicant attempts to establish prior invention by showing an actual reduction to practice of the invention prior to November 30, 2000, the effective filing date of Dutta.

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

Applicant asserts that a reduction to practice occurred prior to the effective filing date of Dutta, relying upon Exhibit A to show that the date of the "Was the invention built or tested?" subsection of p. 1 is prior to the critical date of November 30, 2000. Applicant has redacted all the information relied upon. Although Applicant may redact dates, the redaction of information is so complete that there is no indication whether the subject of the submitted "Invention Disclosure" was ever reduced to practice. Furthermore, Applicant must establish that what was reduced to practice is within the scope of the claimed invention. As described below, the Exhibit does not support this conclusion.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In *re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In *re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). See MPEP §715.07. The statements in the affidavit provide no more than a broad assertion and does not recite facts sufficient for the Examiner to determine which of the claim limitations are satisfied by the invention described, or whether the invention was in fact completed and successful, and is thus inadequate. Page 3 of Exhibit A merely provides a brief description of the invention and does not provide sufficient detail pertaining to the actual invention. There is no evidence to suggest that the subject matter discussed at that time was the invention as it is presently claimed. Overall, the statements in Exhibit A are lacking in detail, and thus given little weight in overcoming the Dutta reference. Examiner also notes that pages 3 and 4 of Exhibit A contain only signatures and no other identifying link to pages 1 and 2 of the Exhibit, such as an invention number or the like. The burden on the Applicant to provide sufficient proof of invention has not been met by the supplied Exhibit.

Insofar as Applicant is relying on the submitted Invention Disclosure to establish reduction to practice, a written description does not constitute an actual reduction to practice. Furthermore, only the filing of a U.S. patent application which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written description, no matter how complete, does not qualify as an actual reduction to practice. Proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

Accordingly, Applicant has not established prior invention. The position set forth in the Final Rejection is maintained.

It is additionally noted that the evidence submitted is insufficient to establish an actual reduction to practice. For example, the limitation reciting "converting the application-specific content into corresponding device independent formatted data" cannot be found in the Exhibit. The recitation of a "user interface" in the Exhibit provides little detail as to the operation and use of such an interface, whereas the claimed limitation recites "using the support program on the source device to interactively provide additional information associated with the device-independent formatted data". Overall, one of ordinary skill in the art cannot readily ascertain the invention as it is presently claimed from the details provided in the supplied Exhibit. The evidence supplied in Exhibit A describes the broad concept of the inventive idea rather than any specific details, and would not have enabled one of ordinary skill in the art to understand the invention as presently claimed. As it cannot be ascertained from the supplied document that the invention as claimed was actually reduced to practice, an actual reduction to practice prior to the effective date of the Dutta reference cannot be established.

MARC D. THOMPSON
MDT
PRIMARY EXAMINER